



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,745	12/05/2001	Sydney Gordon Low	DAVI138.001APC	1234

20995 7590 01/21/2005

Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

EXAMINER

Nelson, Freda Ann

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,745

Applicant(s)

LOW, SYDNEY GORDON

Examiner

Freda Nelson

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-18 is/are rejected.
- 7) ☒ Claim(s) 3 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/05/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to the communication filed on December 5, 2001. Claims 1-7 and 10-18 are currently pending.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Australia on 06/07/99.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 12/05/01 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. Copy of PTO-1449 attached hereto.

Specification

The disclosure is objected to because of the following informalities:

Page 1, line 12, "organisations" should be "organizations" and

Page 4, line 5, insert "is" before "retained".

Appropriate correction is required.

Claim Objections

Claims 3 and 12 are objected to because of the following informalities:

In claims 3 and 12, on line 1, "affiliate" should be placed after "affiliates".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-7 only recite an abstract idea. The recited steps of merely maintaining a record of content of a communications network accessed by a

user of the network; determining if said content is affiliate content; and generating a charge does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to select an insurance policy over another.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-7 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman et al. (US PG Pub. 2002/0072965) in view of Himmel et al. (Patent Number 6,279,036) In further view of O'Toole, Jr. et al. (US Patent Number 6,279,112).

In claims 1 and 4, Merriman et al. disclose that the ad server uses a database 54 and performs reporting processes 59, management processes 58, derivation of profile processes 52, and advertisement processes 19 (paragraph 0021; FIG. 2). Merriman et al. disclose that when a user using a web browser accesses a web page that is affiliated with the advertising server process, the affiliated page's encoding includes an embedded references to an object provided by the advertising server

process(paragraph 0011). Merriman et al. still further disclose that affiliates are one or more entities that generally for a fee contract with the entity providing the advertisement server permits third party advertisements to be displayed on their websites. Merriman et

al. does not disclose generating a charge for an affiliate based on access of. Merriman et al. does not further disclose generating a charge for said user based on access of other content of said record. Himmell discloses that the data processing system 20 is controlled primarily by computer readable instructions, which can be in the form of software, wherever, or by whatever means such software is stored or accessed. Such software may be executed within the Central Processing Unit (CPU) 50 to cause data processing system 20 to do work (col. 5, lines 1-7; FIG. 2). Himmel et al. disclose a method and apparatus that allows varying rates to be charged to the advertisers for placing their advertisements on a web page based upon whether or not these advertisements are actually seen by the user, and for the amount of time for which the advertisement was viewed (col. 3, lines 47-53). O'Toole, Jr. et al disclose that the client computer activates the embedded link when at least a portion of the document corresponding to the embedded link is displayed, records activation of the embedded link to be transmitted to the server computer wherein this process makes it possible to charge a user on a per-usage basis for the user's access to information (col. 3, lines 21-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Merriman et al. to include the charging feature of Himmel et al. and the charging feature of O'Toole, Jr. et al. in order to get the

advantage of having one system that would allow rates to be charged to the users and affiliates based on the content viewed.

In claim 2, Merriman et al. disclose that the ad server uses a database⁵⁴ and performs reporting processes 59, management processes 58, derivation of profile processes 52, and advertisement processes 19 (paragraph 0021; FIG. 2).

In claim 3, Merriman et al. disclose that the basic architecture of the network 10 comprises at least one affiliate web site 12, an advertisement (ad) server web site 19 and one or more individual advertiser's web sites 18. Affiliates are one or more entities that generally for a fee contract with the entity providing the advertisement server permit third party advertisements to be displayed on their web sites (paragraph 0016).

In claim 5, Merriman et al. disclose that the relative time of day for the user is calculated based upon either the user's country code or the user's IP access provider or the location of their domain (paragraph 0028).

In claim 6, Merriman et al. disclose that the report process 59 is used for generating online reports about the success rate of the advertisement and statistics on the users that are viewing and clicking through the various advertisements and are also updating the counters in the database that store how often an advertisement has been displayed (paragraph 0021).

In claim 7, Merriman et al. disclose that the ad server uses a database 54 and performs reporting processes 59, management processes 58, derivation of profile processes 52, and advertisement processes 19 (paragraph 0021; FIG. 2). Merriman et al. does not disclose a charging system. Merriman et al. does further disclose

generating a charge for an affiliate based on access of said affiliate content. Merriman et al. does not still further disclose generating a charge for said user based on access of other content of said record. Himmel et al. disclose a method and apparatus that allows varying rates to be charged to the advertisers for placing their advertisements on a web page based upon whether or not these advertisements are actually seen by the user, and for the amount of time for which the advertisement was viewed (col. 3, lines 47-53). O'Toole, Jr. et al disclose a network-based system for controlled transfer of information that includes a client computer, a server computer, and an information source computer interconnected by a computer network (col. 1, lines 54-57). O'Toole jr. et al. further disclose that the client computer activates the embedded link when at least a portion of the document corresponding to the embedded link is displayed, records activation of the embedded link to be transmitted to the server computer wherein this process makes it possible to charge a user on a per-usage basis for the user's access to information (col. 3, lines 21-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Merriman et al. to include the charging system of Himmel et al. and the charging feature of O'Toole, Jr. et al. in order to get the advantage of having one system that would allow rates to be charged to the users and affiliates based on the content viewed.

In claim 10, Merriman et al. disclose that the ad server uses a database⁵⁴ and performs reporting processes 59, management processes 58, derivation of profile processes 52, and advertisement processes 19 (paragraph 0021; FIG. 2). Merriman et al. disclose that when a user using a web browser accesses a web page that is affiliated

with the advertising server process, the affiliated page's encoding includes an embedded references to an object provided by the advertising server process (paragraph 0011). Merriman et al. still further disclose that affiliates are one or more entities that generally for a fee contract with the entity providing the advertisement server permits third party advertisements to be displayed on their websites. Merriman et

al. does not disclose generating a charge for an affiliate based on access of said affiliate content. Merriman et al. does not further disclose generating a charge for said user based on access of other content of said record. Himmell discloses that the data processing system 20 is controlled primarily by computer readable instructions, which can be in the form of software, wherever, or by whatever means such software is stored or accessed. Such software may be executed within the Central Processing Unit (CPU) 50 to cause data processing system 20 to do work. Himmel et al. disclose a method and apparatus that allows varying rates to be charged to the advertisers for placing their advertisements on a web page based upon whether or not these advertisements are actually seen by the user, and for the amount of time for which the advertisement was viewed (col. 3, lines 47-53). O'Toole, Jr. et al disclose that the client computer activates the embedded link when at least a portion of the document corresponding to the embedded link is displayed, records activation of the embedded link to be transmitted to the server computer wherein this process makes it possible to charge a user on a per-usage basis for the user's access to information (col. 3, lines 21-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Merriman et al. to include the charging

feature of Himmel et al. and the charging feature of O'Toole, Jr. et al. in order to get the advantage of having one system that would allow rates to be charged to the users and affiliates based on the content viewed.

In claim 11, Merriman et al. disclose that when a user using a web browser accesses a web page that is affiliated with the advertising server process, the affiliated page's encoding includes an embedded references to an object provided by the advertising server process (paragraph 0011).

In claim 12, Merriman et al. disclose that the ad server uses a database⁵⁴ and performs reporting processes 59, management processes 58, derivation of profile processes 52, and advertisement processes 19 (paragraph 0021; FIG. 2).

In claim 13, Merriman et al. disclose that the basic architecture of the network 10 comprises at least one affiliate web site 12, an advertisement (ad) server web site 19 and one or more individual advertiser's web sites 18. Affiliates are one or more entities that generally for a fee contract with the entity providing the advertisement server permits third party advertisements to be displayed on their web sites (paragraph 0016).

In claim 14, Merriman et al. disclose that the relative time of day for the user is calculated based upon either the user's country code or the user's IP access provider or the location of their domain (paragraph 0028).

In claim 15, Merriman et al. disclose that the report process 59 is used for generating online reports about the success rate of the advertisement and statistics on the users that are viewing and clicking through the various advertisements and are also

updating the counters in the database that store how often an advertisement has been displayed (paragraph 0021).

In claim 16, Merriman et al. disclose that the ad server uses a database 54 and performs reporting processes 59, management processes 58, derivation of profile processes 52, and advertisement processes 19 (paragraph 0021; FIG. 2). Merriman et al. does not disclose generating a charge for an affiliate based on access of said affiliate content. Merriman et al. does not further disclose generating a charge for said user based on access of other content of said record. Himmell discloses that the data processing system 20 is controlled primarily by computer readable instructions, which can be in the form of software, wherever, or by whatever means such software is stored or accessed. Such software may be executed within the Central Processing Unit (CPU) 50 to cause data processing system 20 to do work (col. 5, lines 1-7; FIG. 2). Himmel et al. further disclose a method and apparatus that allows varying rates to be charged to the advertisers for placing their advertisements on a web page based upon whether or not these advertisements are actually seen by the user, and for the amount of time for which the advertisement was viewed (col. 3, lines 47-53). O'Toole, Jr. et al disclose that the client computer activates the embedded link when at least a portion of the document corresponding to the embedded link is displayed, records activation of the embedded link to be transmitted to the server computer wherein this process makes it possible to charge a user on a per-usage basis for the user's access to information (col. 3, lines 21-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Merriman et al. to include the

Art Unit: 3629

charging feature of Himmel et al. and the charging feature of O'Toole, Jr. et al. in order to get the advantage of having one system that would allow rates to be charged to the users and affiliates based on the content viewed.

In claim 17, Merriman et al. disclose that the ad server uses a database 54 and performs reporting processes 59, management processes 58, derivation of profile processes 52, and advertisement processes 19 (paragraph 0021; FIG. 2). Merriman et al. disclose that when a user using a web browser accesses a web page that is affiliated with the advertising server process, the affiliated page's encoding includes an embedded references to an object provided by the advertising server process (paragraph 0011). Merriman et al. still further disclose that affiliates are one or more entities that generally for a fee contract with the entity providing the advertisement server permits third party advertisements to be displayed on their websites. Merriman et

al. does not disclose generating a charge for an affiliate based on access of. Merriman et al. does not further disclose generating a charge for said user based on access of other content of said record. Himmell discloses that the data processing system 20 is controlled primarily by computer readable instructions, which can be in the form of software, wherever, or by whatever means such software is stored or accessed. Such software may be executed within the Central Processing Unit (CPU) 50 to cause data processing system 20 to do work (col. 5, lines 1-7, FIG. 2). Himmel et al. disclose a method and apparatus that allows varying rates to be charged to the advertisers for placing their advertisements on a web page based upon whether or not these advertisements are actually seen by the user, and for the amount of time for

which the advertisement was viewed (col. 3, lines 47-53). O'Toole, Jr. et al disclose that the client computer activates the embedded link when at least a portion of the document corresponding to the embedded link is displayed, records activation of the embedded link to be transmitted to the server computer wherein this process makes it possible to charge a user on a per-usage basis for the user's access to information (col. 3, lines 21-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Merriman et al. to include the charging feature of Himmel et al. and the charging feature of O'Toole, Jr. et al. in order to get the advantage of having one system that would allow rates to be charged to the users and affiliates based on the content viewed.

In claim 18, Merriman et al. disclose that the ad server uses a database 54 and performs reporting processes 59, management processes 58, derivation of profile processes 52, and advertisement processes 19 (paragraph 0021; FIG. 2). Merriman et al. disclose that when a user using a web browser accesses a web page that is affiliated with the advertising server process, the affiliated page's encoding includes an embedded references to an object provided by the advertising server process (paragraph 0011). Merriman et al. still further disclose that affiliates are one or more entities that generally for a fee contract with the entity providing the advertisement server permit third party advertisements to be displayed on their websites. Merriman et al. does not disclose generating a charge for an affiliate based on access of. Merriman et al. does not further disclose generating a charge for said user based on access of other content of said record. Himmell discloses that the data

processing system 20 is controlled primarily by computer readable instructions, which can be in the form of software, wherever, or by whatever means such software is stored or accessed. Such software may be executed within the Central Processing Unit (CPU) 50 to cause data processing system 20 to do work (col. 5, lines 1-7, FIG. 2.

Himmel et al. disclose a method and apparatus that allows varying rates to be charged to the advertisers for placing their advertisements on a web page based upon whether or not these advertisements are actually seen by the user, and for the amount of time for which the advertisement was viewed (col. 3, lines 47-53). O'Toole, Jr. et al disclose that the client computer activates the embedded link when at least a portion of the document corresponding to the embedded link is displayed, records activation of the embedded link to be transmitted to the server computer wherein this process makes it possible to charge a user on a per-usage basis for the user's access to information (col. 3, lines 21-30). It would have been obvious to modify the invention of Merriman et al. to include the charging feature of Himmel et al. and the charging feature of O'Toole, Jr. et al. in order to get the advantage of providing one system that would allow rates to be charged to the users and affiliates based on the content viewed.

Conclusion

1. The examiner has cited prior art of interest, for example:

1) Malkin et al. (Patent Number 6,085, 193), which disclose a method and system for dynamic prefetching information via a server hierarchy.

2) Reisman (US PG Pub. 2002/0129094), which discloses a software and method for automatically sending a data object that includes user demographics.

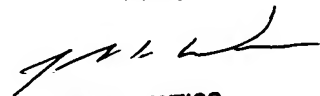
3) Angeles et al. (Patent Number 5,933,811), which disclose a system and method for delivering customized advertisements within interactive communications systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda Nelson whose telephone number is (703) 305-0261. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Freda Nelson
Examiner
Art Unit 3629



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600